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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,206	11/25/2003	William Hallen Falls JR.	MR1035-1346	4075

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ROSENBERG, KLEIN & LEE  
3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER
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DIXON, ANNETTE FREDRICKA

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/720,206	Applicant(s) FALLS ET AL.	
	Examiner Annette F. Dixon	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 38-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 21, 2006, has been entered.

### ***Specification***

2. The amendment filed April 21, 2006, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention after its filing date. (See MPEP §608.04). The added material which is not supported by the original disclosure is as follows: In the abstract, "the hem ~~can be~~ is stitched with a thread of a different color than the color of the fabric to make the towel..." and in the specification, "the color of the tread ~~can be the same color as the towel; however, to add further advantages, the color of the thread can be~~ is a different color than the color of the towel." Applicant introduces the concept of the hem color being different from the towel as a further advantage to aide in the identification of an x-ray detectable towel. However, Applicant's modification of the disclosure has added a negative limitation or exclusionary proviso to the disclosure in an attempt to amend around the cited prior art.

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Yet from a close reading of Applicant's disclosure, there is no specific recitation or support disclosing the hem color MUST (and therefore, IS) a different from the fabric color of the towel in the original disclosure as filed; therefore, the subject matter added to the disclosure is considered new matter and Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

3. **Claim 49, 50, 56 and 57** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
4. Regarding dependent **Claims 49 and 50**, independent **Claim 45** recites the sheet to be single-ply woven cotton fabric. However, in **Claim 49**, Applicant recites the sheet to comprise cotton, synthetic material, or a combination thereof and in **Claim 50**, Applicant recites the sheet to be made of a single-ply. Both of the limitations recited in **Claims 49 and 50** have been addressed in independent **Claim 45** and thus fail to further limit the subject matter claimed in independent **Claim 45**. Appropriate correction is required.
5. Regarding dependent **Claims 56 and 57**, independent **Claim 52** recites the sheet to be single-ply woven cotton fabric. However, in **Claim 56**, Applicant recites the sheet to comprise cotton, synthetic material, or a combination thereof and in **Claim 50**, Applicant recites the sheet to be made of a single-ply. Both of the limitations recited in

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**Claims 56 and 57** have been addressed in independent **Claim 52** and thus fail to further limit the subject matter claimed in independent **Claim 52**. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 38, 39, 42-46, 49, 50, and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US 4205680 A) in view of McAvinn (US 4244369 A).

8. **As to Claim 38**, Marshall discloses a surgical towel (10) comprising a sheet of woven fabric comprising at least one stitched hem (Figures 1 and 2), a thread for stitching the hem (22), and at least one piece of x-ray detectable material (21) attached to the fabric by the thread, the x-ray material protruding from the hem (Figures 1 and 2) allowing visual identification of the x-ray material's location, the x-ray detectable material comprising identifying characteristics to identify an x-rayed object as a surgical towel (Column 1). Yet, Marshall does not expressly disclose the limitation of the thread to be of a different color than the fabric for stitching the hem and the thread color to be visually identifying the surgical towel as x-ray detectable. However, at the time the invention was made it was well known for thread to be a different color than the fabric. Specifically, McAvinn teaches the use of a thread (22) that is highly reflective and

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contrasts with the color of blood for the purpose of increasing the visibility of the absorbent material in the presence of blood. (Column 2). Further, McAvinn discloses the composition of the thread to have a central layer (24) made of a metallic reflective material sandwiched between two transparent outer layers (26), which enable the metallic central layer to be seen. (Figure 3). Naturally the reflective nature of the thread will distinguish from the color of the fabric regardless of saturation by blood or water, and regardless of the color in which the towel has been dyed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the article of Marshall to include a thread color different from the fabric to increase the visibility of the absorbent article whether inside or outside the body, as taught by McAvinn.

9. **As to Claim 45**, Marshall discloses a surgical towel (10) comprising a sheet of woven fabric comprising at least one stitched hem (Figures 1 and 2), a thread for stitching the hem (22), and at least one piece of x-ray detectable material (21) attached to the fabric by the thread, the x-ray material protruding from the hem (Figures 1 and 2) allowing visual identification of the x-ray material's location, the x-ray detectable material comprising identifying characteristics to identify an x-rayed object as a surgical towel (Column 1). Yet, Marshall does not expressly disclose neither the ply ratio of the sheet of woven cotton fabric nor the limitation of the thread to be of a different color than the fabric for stitching the hem and the thread color to be visually identifying the surgical towel as x-ray detectable. However, at the time the invention was made the ply ratio and thread of different color than fabric was well known. Regarding the ply ratio, it is

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well known that the medical personnel would choose a ply-ratio commensurate with the surgical procedure being preformed. For example the absorptive quality required for a nosebleed is substantially less than the absorptive quality requirement for an open-heart surgery procedure. Moreover, Applicant has not asserted that the specific ply ratio recited provides a particular advantage, solves a stated problem, or serves a purpose different from that of providing a pliable absorptive material for insertion into the body during a surgical procedure, thus the use of a single-ply towel lacks criticality in its design. Furthermore, one of ordinary skill in the art would choose a ply-ratio commensurate with the surgical procedure being preformed. Regarding the thread color, McAvinn teaches the use of a thread (22) that is highly reflective and contrasts with the color of blood for the purpose of increasing the visibility of the absorbent material in the presence of blood. (Column 2). Further McAvinn discloses the composition of the thread to have a central layer (24) made of a metallic reflective material sandwiched between two transparent outer layers (26), which enable the metallic central layer to be seen. (Figure 3). Naturally the reflective nature of the thread will distinguish from the color of the fabric regardless of saturation by blood or water, and regardless of the color in which the towel has been dyed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the article of Marshall to include a thread color different from the fabric to increase the visibility of the absorbent article whether inside or outside the body.

10. **As to Claims 42 and 49**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet the limitation of the woven fabric to be

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made of cotton, synthetic material or a combination thereof has yet to be discussed.

However, at the time the invention was made the use of cotton, synthetic material or a combination thereof was well known. Specifically, McAvinn uses cotton because of its absorptive quality and open mesh structure. (Column 2, Lines 30-35). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Marshall as modified by McAvinn to include woven cotton because of its absorptive nature.

11. **As to Claims 43 and 50**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet does not expressly disclose the single-ply characteristics of the sheet. However, at the time the invention was made ply-ratios were well known. Specifically, it is well known that the medical personnel would choose a ply-ratio commensurate with the surgical procedure being preformed. For example the absorptive quality required for a nosebleed is substantially less than the absorptive quality requirement for an open-heart surgery procedure. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn to have a ply ratio capable of assisting medical personnel in the effective containment of fluid in medical procedures.

12. **As to Claims 44 and 51**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet the limitations of the physical characteristics of the x-ray detectable material to be a flexible strip through which the hem stitching is sewn have yet to be discussed. However, at the time the invention was made the recited physical characteristics of the x-ray detectable material were known.

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Specifically, McAvinn teaches the “filament (20) may be made of a thermoplastic polymeric material containing a radiopaque material such as barium sulfate. (Column 2, Lines 43-46). Naturally, the composition of the filament and the placement of the filament into the woven cloth would allow for some flexibility in the strip. Further, depending on the placement of the strip, the strip may be sewn in place to maintain the location of the radioactive element. Finally, McAvinn’s flexible strip serves a purpose of providing a means for smooth incorporation into the sheet (12). (Figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Marshall to incorporate the flexible strip of McAvinn for the purpose of maintaining the pliable nature of the fabric while providing x-ray detectable material.

13. **As to Claims 39 and 46**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet the limitations of the x-ray material being made of Barite, Barium, or  $\text{BaSO}_4$ . However, at the time the invention was made, the use of Barium sulfate ( $\text{BaSO}_4$ ) for x-ray detection was well known. Specifically, McAvinn teaches the “filament (20) may be made of a thermoplastic polymeric material containing a radiopaque material such as barium sulfate.” (Column 2, Lines 43-46). Barium Sulfate is a well-known material that is used in x-ray detection because of its ability to be safely introduced into the body. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

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14. **Claims 40, 41, 47, and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US 4205680 A) in view of McAvinn (US 4244369 A), and further in view of Debusk (US 5792128 A).

15. **As to Claims 40 and 47**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet does not expressly disclose the x-ray detectable material comprising polyvinyl chloride (PVC). However, the use of the recited x-ray detectable materials was known at the time the invention was made. Specifically, Debusk teaches an x-ray detectable material comprising 60% BaSO<sub>4</sub> and 40% PVC (see "polyvinyl chloride filled with at least about 60%...barium sulfate" in lines 30-32 of Column 4) for the purpose of a safe radioactive material capable of being used within the body for x-ray detection. Finally, the recited x-ray detection materials are well-known materials that are used in x-ray detection because of its ability to be safely introduced into the body. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

16. **As to Claims 41 and 48**, the system of Marshall as modified by McAvinn is discussed in **Claims 38 and 45**, respectively, yet does not expressly disclose the x-ray detectable material having 60% BaSO<sub>4</sub> and 40% PVC. However, the use of the recited x-ray detectable materials was known at the time the invention was made. Specifically, Debusk teaches an x-ray detectable material comprising 60% BaSO<sub>4</sub> and 40% PVC (see "polyvinyl chloride filled with at least about 60%...barium sulfate" in lines 30-32 of Column 4) for the purpose of a safe radioactive material capable of being used within

the body for x-ray detection. Finally, the recited x-ray detection materials are well-known materials that are used in x-ray detection because of its ability to be safely introduced into the body. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

17. **Claims 52, 53, 56, are 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over McAvinn (US 4244369 A).

18. **As to Claim 52**, McAvinn discloses a surgical towel (absorbent article) comprising, a sheet of woven cotton fabric (12) having four (4) edges (Figures 1, 6, and 7), at least one hem stitched in at least one of the four edges (Figure 6), a thread of a different color (22) than a color of the cotton fabric for stitching the at least one hem, the color of the thread visually identifying the surgical towel as x-ray detectable; and at least one piece of x-ray detectable material (20) through which the hem stitching is sewn, the x-ray detectable material protruding from the hem but not extending past the edge of the fabric, allowing visual identification of the x-ray detectable material's location, the x-ray detectable material comprising identifying characteristics to identify an x-rayed object as a surgical towel. Regarding the surgical towel limitation, McAvinn discloses an invention related to "absorbent articles and more particularly to surgical sponges. Because McAvinn's invention is in a surgical environment absorbent articles broadly includes towels. Regarding the placement of the x-ray detectable material, McAvinn discloses the x-ray detectable material (20) located with in the sheet (12). As well

known in the art, the stitching of the x-ray detectable material through the hem would contain the movement of the x-ray detectable material with in the sheet (12). Further, the stitching pattern disclosed in Figure 6 contains vertical hem lines parallel to edges (18a and 18b), the placement of the x-ray detectable material inside the these hemlines enables the placement of the x-ray detectable material to not extend past the edge of the fabric. Yet, McAvinn does not teach the single-ply ratio of the sheet. However, at the time the invention was made the ply ratio and thus absorptive quality of a towel would be modified by the medical personnel depending on the procedure being performed. For example the absorptive quality required for a nosebleed is substantially less than the absorptive quality requirement for an open-heart surgery procedure. Moreover, Applicant has not asserted that the specific ply ratio recited provides a particular advantage, solves a stated problem, or serves a purpose different from that of providing a pliable absorptive material for insertion into the body during a surgical procedure, thus the use of a single-ply towel lacks criticality in its design. Furthermore, one of ordinary skill in the art would choose a ply-ratio commensurate with the surgical procedure being preformed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the article of McAvinn to effectively control and identify the absorptive needs of the patient.

19. **As to Claim 53**, McAvinn is discussed in **Claim 52**, yet the limitations of the x-ray material being made of Barite, Barium, or  $\text{BaSO}_4$  have yet to be discussed. However, at the time the invention was made, the use of Barium sulfate ( $\text{BaSO}_4$ ) for x-ray detection was well known. Specifically, McAvinn teaches the "filament (20) may be

made of a thermoplastic polymeric material containing a radiopaque material such as barium sulfate.” (Column 2, Lines 43-46). Barium Sulfate is a well-known material that is used in x-ray detection because of its ability to be safely introduced into the body.

Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

20. **As to Claim 56**, McAvinn is discussed in **Claim 52**, yet the limitations of the woven fabric to be made of cotton, synthetic material or a combination thereof have yet to be discussed. However, at the time the invention was made the use of cotton, synthetic material or a combination thereof was well known. Specifically, McAvinn uses cotton because of its absorptive quality and open mesh structure. (Column 2, Lines 30-35). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Marshall as modified by McAvinn to include woven cotton because of its absorptive nature.

21. **As to Claim 57**, McAvinn is discussed in **Claim 52**, yet does not expressly disclose the single-ply characteristics of the sheet. However, at the time the invention was made ply-ratios were well known. Specifically, it is well known that the medical personnel would choose a ply-ratio commensurate with the surgical procedure being preformed. For example the absorptive quality required for a nosebleed is substantially less than the absorptive quality requirement for an open-heart surgery procedure. Therefore it would have been obvious to one having ordinary skill in the art to modify the

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system of Marshall as modified by McAvinn to have a ply ratio capable of assisting medical personnel in the effective containment of fluid in medical procedures.

22. **Claims 54-55** are rejected under 35 U.S.C. 103(a) as being unpatentable over McAvinn (US 4244369 A) in view of Debusk (US 5792128 A).

23. **As to Claim 54**, McAvinn is discussed in **Claim 52**, yet does not expressly disclose the x-ray detectable material comprising polyvinyl chloride (PVC). However, the use of the recited x-ray detectable materials were known at the time the invention was made. Specifically, Debusk teaches an x-ray detectable material comprising 60% BaSO<sub>4</sub> and 40% PVC (see "polyvinyl chloride filled with at least about 60%...barium sulfate" in lines 30-32 of Column 4) for the purpose of a safe radioactive material capable of being used within the body for x-ray detection. Finally, the recited x-ray detection materials are well-known materials that are used in x-ray detection because of its ability to be safely introduced into the body. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

24. **As to Claim 55**, McAvinn is discussed in **Claims 52**, yet does not expressly disclose the x-ray detectable material having 60% BaSO<sub>4</sub> and 40% PVC. However, the use of the recited x-ray detectable materials were known at the time the invention was made. Specifically, Debusk teaches an x-ray detectable material comprising 60% BaSO<sub>4</sub> and 40% PVC (see "polyvinyl chloride filled with at least about 60%...barium

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sulfate" in lines 30-32 of Column 4) for the purpose of a safe radioactive material capable of being used within the body for x-ray detection. Finally, the recited x-ray detection materials are well-known materials that are used in x-ray detection because of its ability to be safely introduced into the body. Therefore it would have been obvious to one having ordinary skill in the art to modify the system of Marshall as modified by McAvinn for the purpose maintaining patient safety while providing a means for x-ray detection.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The balance of art listed by US patent number below, shows additional inventions in the field of articles capable of being used as surgical towels in detection environments.


Dyer; John et al.	US 5045080
Fabian, Carl E.	US 20050049563
Papp, Jr.; Stephen	US 4935019
Shen; Albert	US 4626251
Taylor; Jeffrey L.	US 4626311

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette F. Dixon whose telephone number is (571) 272-3392. The examiner can normally be reached on Monday thru Friday.

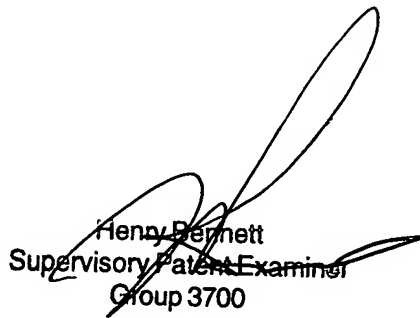
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AFD  
July 31, 2006



Henry Bennett  
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